

REMARKS

Claims 173-194, 196-203, 205-211 and 231 are pending in the application. All the pending claims have been rejected. For reasons to be presented below, it is requested that the rejections be withdrawn and that the claims be allowed to issue.

I. Rejections Under The Judicially Created Doctrine of Obviousness-Type Double Patenting Should Be Withdrawn

A. The '722 Patent

Claims 173-194, 196-203, 205-211 and 231 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 5,595,722 to Grainger et al. ("the '722 patent"). Specifically, the Examiner states that the methods and compounds claimed in the present invention are disclosed in the specification of the '722 patent.

Applicants respectfully assert that the basic concept of double patenting is that the same invention cannot be *patented* more than once. Accordingly, a double patenting rejection must rely only on a comparison of the *claims* in an issued patent. Indeed, the Federal Circuit has made clear that "the *disclosure* of a patent cited in support of a double patenting rejection cannot be used as though it were prior art, *even where the disclosure is found in the claims.*" See *General Foods Corp. v Studiengesellschaft Kohle*, 972 F.2d 1272, 1281 (Fed Cir. 1992) (emphasis in original); See also *In re Vogel*, 422 F.2d 438, 442 (CCPA 1970) (in considering obviousness-type double patenting, "the patent disclosure may not be used as prior art"). Thus, "comparison can be made only with what invention is *claimed* in the earlier patent..." *General Foods Corp.*, 972 F.2d at 1280 (emphasis in original).

Claims 1-7 of the '722 patent are directed to a method for *identifying an agent* which increases the level of TGF-beta in a human. Consequently, Claims 1-7 of the '722 patent do not disclose or suggest the use of Formula (I) as claimed in the present invention. Furthermore, claims 1-7 of the '722 patent do not disclose or suggest that a compound of Formula (I) would increase the level of TGF-beta, or is useful to prevent or treat a cardiovascular or vascular indication characterized by a decreased lumen diameter. Thus, the methods of the presently claimed invention are not disclosed or suggested by the claims of the '722 patent.

Therefore, in view of the foregoing, reconsideration and withdrawal of the rejection of claims 173-194, 196-203, 205-211 and 231 under the judicially created doctrine of obviousness-type double patenting in view of U.S. Patent No. 5,595,722 to Grainger et al. ("the '722 patent") is respectfully requested.

B. The '911 Patent

Claims 173-194, 196-203, 205-211 and 231 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,117,911 to Grainger et al. ("the '911 patent")

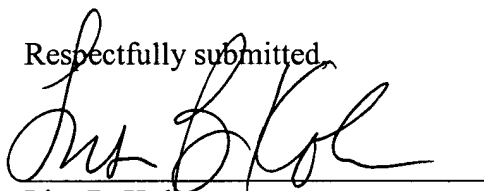
Applicants file herewith a terminal disclaimer in compliance with 37C.F.R. 1.321(c) to overcome the rejection based on the judicially created doctrine of double patenting, to disclaim the terminal part of the statutory term of any patent granted on the above-identifies application, which would extend beyond the expiration date of the '911 patent.

Therefore, in view of the foregoing, reconsideration and withdrawal of the rejection of claims 173-194, 196-203, 205-211 and 231 under the judicially created doctrine of obviousness-type double patenting in view of the '911 patent is respectfully requested.

II. Conclusion

In view of the foregoing remarks, reconsideration and allowance is earnestly requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Lisa B. Kole', written over a horizontal line.

Lisa B. Kole
Patent Office Reg. No. 35,225
Attorney for Applicant
(212) 408-2628

Baker Botts L.L.P.
30 Rockefeller Plaza
New York NY 10112